

## **REMARKS**

Claims 1-3, 5-7 and 14-27 are pending in the present application. In this amendment, claims 4 and 8-13 are canceled herein without prejudice or disclaimer of the subject matter recited therein, claims 1, 2, 14 and 17 are amended and claims 18-27 are newly added. No new matter has been introduced by this amendment. Applicant respectfully requests reconsideration of the claims in view of the following remarks.

Claims 8-13 are canceled herein to minimize excess claim fees. Applicant reserves the right to pursue the original scope of the canceled and/or amended claims in this or another application.

### ***Allowable Claims***

Applicant acknowledges with appreciation the indication of the allowable subject matter in claims 3-16. As suggested by the Office Action, independent claim 1 is amended by incorporating all further limitations of original dependent claim 4 which is considered as allowable subject matter, and thus, amended claim 1 is allowable.

### ***Prior Art Rejections***

Claims 1-2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hulkkonen (U.S. Patent Application Publication No. 2004/0029587, hereinafter "Hulkkonen") in view of Dalvie (U.S. Patent No. 7,062,270, hereinafter "Dalvie"). Dependent claim 17 is rejected as being unpatentable over Hulkkonen, in view of Dalvie, further in view of Phu (U.S. Patent No. 7,623,504, hereinafter "Phu"). Applicant respectfully traverses these rejections.

As suggested by the Office Action, original claim 4 is rewritten as independent form (i.e., amended claim 1), and thus, claim 1 is allowable over the references of record. Claims 2-3, 5-6,

14-17 depend directly or indirectly from amended independent claim 1, and thus are allowable as well over the cited references.

### *New Claims*

New claims 18-27 are added herein and contain no new matter. Claims 18 and 24 are independent claims, claims 19-23 and 25-27 depend from claims 18 and 24 respectively.

Applicant respectfully submits that these claims 18-27 are patentable as well over the cited references because the references of record fail to disclose all the limitations of these claims.

New independent claim 18 provides that (1) the mobile station includes a list identifying access technologies and mobile networks to which the mobile station is not allowed to access (2) that the list is stored in the mobile station. In contrast, Hulkkonen's list is for identifying only all access networks to which a user equipment is allowed to be handed over and the list is stored in his core network, not his user equipment.

The invention relates to a method for supporting a handover of a user equipment (15) from a first radio access network (11) to a second radio access network (13). In order to ensure the success of the handover, it is proposed that a core network stores at least for some user equipment (15) a list identifying all radio access network, (11, 13) to which the respective user equipment (15) is allowed to be hander over...The invention equally relates to a core network, a network element of a core network and a network element of a radio access network that are designed for carrying out the proposed method.

This object is reached on the hand with a method for supporting a handover of a user equipment from a first radio access network to a second radio access network, wherein a core network to which the first radio access network is connected transmits information stored in said core network to the first radio access network, which information indicates to which radio access networks the user equipment is permitted to be hander over.

....Since the core network of a PLMN has knowledge about roaming agreements with the operations with the operators of other networks, it is suited best to store such information....

Hulkkonen, Abstract and ¶¶ 19 & 22 (Emphasis added). As shown above, Hulkkonen's list/information is for identifying only the radio access networks that a user equipment is permitted to be handed over and it is Hulkkonen's core network, not his user equipment stores his list/information. Thus, Hulkkonen teaches away from the recitation of claim 18 and claims depending therefrom, and cannot properly support a rejection of these claims.

Dalvie does not cure the deficiencies in Hulkkonen because Dalvie fails to disclose the limitations of claim 18.

In the present invention, a home network of a mobile includes a Roaming Enhancement Node (REN) 320. The REN includes a database that contains a list of restricted location areas for the home network operator. The REN determines whether to continue registration... in response to a location update request from the mobile.

Dalvie, col. 3, lines 19-22 and lines 69-67 (emphasis added); *see also*, FIG. 3. As shown above, Dalvie's list is only of restricted location areas, but as discussed above, in claim 18, the list identifies both access technologies and mobile networks to which the mobile station is not allowed to access. Furthermore, Dalvie's list of restricted location areas is stored in his REN 320 of home network rather than in a mobile station as of claim 18. As such, Dalvie is no closer to the recitation of new claim 18 than was Hulkkonen, and therefore cannot properly support a rejection of these claims. Phu also fails to make up the above deficiencies in Hulkkonen and Dalvie.

Therefore, the combination of the references fails to disclose at least the above elements of independent claim 18, and consequently fails to render obvious claim 18. As such, claim 18 are patentable over the references of record. Claims 19-23 depend from claim 18 and add additional limitations, and thus, are allowable as well.

New independent claim 24 is directed a system claim which comprises a mobile station communicatively connected with a mobile network, wherein the mobile station comprises a first unit configured to store a list identifying mobile network networks and access technologies to which the mobile station is not permitted to access; a second unit configured to check, when the mobile station selects a PLMN network to access via an access technology, whether the selected network and the corresponding access technology are not permitted for the mobile station to access by inquiring the list; and a third unit configured to determine not to send a request for access the access network to a core network if the selected network or the access technology is not permitted for the mobile station to access, or configured to send a request to the core network in order to access the selected network if the selected network or the access technology is permitted for the mobile station to access.

As seen, claim 24 also provides that (1) the mobile station includes a list identifying access technologies and mobile networks to which the mobile station is not allowed to access and that (2) the list is stored in the mobile station. As discussed above with respect to claim 18, for at least these reasons, claim 24 is allowable.

Claims 25-27 depend from claim 24 and add further limitations, and therefore, are allowable over the references of records as well in view of their dependence on an allowable claim as well as the additional limitations.

### ***Conclusion***

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Ira S. Matsil, Applicant's attorney, at 972-732-1001 so that such issues may be resolved as expeditiously as possible. The Commissioner is hereby

authorized to charge any fees that are due, or credit any overpayment, to Deposit Account No.

50-1065.

Respectfully submitted,



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Date

Ira S. Matsil  
Attorney for Applicant  
Reg. No. 35,272

SLATER & MATSIL, L.L.P.  
17950 Preston Rd., Suite 1000  
Dallas, Texas 75252  
Tel.: 972-732-1001  
Fax: 972-732-9218